

### **REMARKS/ARGUMENTS**

Claims 1-20 are pending in the present application. In the Office Action mailed March 10, 2005, the Examiner rejected claims 1-2, 4-6, 8-10, 12-15 and 17-20 under 35 U.S.C. § 102. The Examiner also rejected claims 3, 7, 11 and 16 under 35 U.S.C. § 103. The Examiner also rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

#### **A. Informality – Information Disclosure Statement**

Applicants have previously submitted an Information Disclosure Statement, which was mailed on March 19, 2004. Applicants did receive a copy of the PTO-1449A form that had been initialed by the Examiner with the Office Action. However, Applicants did not receive the PTO-1449B form with the Examiner's initial's by the references on the PTO-1449B form. A copy of the PTO-1449B form that was submitted is attached hereto in Appendix A. Accordingly, Applicants hereby request that the Examiner initial these references on the PTO-1449B form, as well as sign and date the form, as having been considered and transmit the same to Applicants' Attorney of Record.

#### **B. Rejection of Claims 1-20 – Double Patenting**

The Office Action also rejected the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,697,466 issued to Michael L. Howard et al. Applicant herewith files a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the rejection. The terminal disclaimer is enclosed.

#### **C. Claims 1-2, 4-6, 8-10, 12-15 and 17-20 Rejected Under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1-2, 4-6, 8-10, 12-15 and 17-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,987,105 to Jenkins et al. (hereinafter, "Jenkins"). This rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, “the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that the claims at issue are patentably distinct from Jenkins. Jenkins does not disclose all of the limitations in these claims.

Claim 1 has been amended to recite “an identification for identifying the embedded device wherein the identification is stored in the memory.” Support for this amendment may be found through Applicants’ specification on page 8, lines 14-17 and Figure 4. Jenkins does not disclose “an identification for identifying the embedded device” as recited in the amended claim 1.

Claim 1 has been further amended to recite “accessing the identification...” and “including the identification with the status data.” Support for these amendments may also be found through Applicants’ specification on page 8, lines 14-17 and Figure 4. Jenkins does not disclose “accessing the identification...” and “including the identification with the status data” as recited in the amended claim 1.

Claim 9 has been amended to recite “an identification for identifying the embedded device where the identification is stored in the memory.” Support for this amendment may be found through Applicants’ specification on page 8, lines 14-17 and Figure 4. Jenkins does not disclose “an identification for identifying the embedded device” as recited in the amended claim 9.

Claim 9 has been further amended to recite “accessing the identification...” and “including the identification with the status data.” Support for these amendments may be found through Applicants’ specification on page 8, lines 14-17 and Figure 4. Jenkins does not disclose “accessing

the identification...” and “including the identification with the status data” as recited in the amended claim 9.

Claim 15 has been amended to recite “accessing an identification stored in memory...that identifies the embedded device” and “including the identification with the status data.” Support for these amendments may be found through Applicants’ specification on page 8, lines 14-17 and Figure 4. Jenkins does not disclose “accessing an identification...that identifies the embedded device” and “including the identification with the status data” as recited in the amended claim 15.

In view of the foregoing, Applicants respectfully submit that independent claims 1, 9, and 15 are patentably distinct from Jenkins. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 2, 4-6, and 8 depend either directly or indirectly from claim 1. Claims 10 and 12-14 depend either directly or indirectly from claim 9. Claims 17-20 depend either directly or indirectly from claim 15. Accordingly, Applicants respectfully request that the rejection of claims 2, 4-6, 8, 10, 12-14, and 17-20 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 9, and 15.

D. Rejection of Claims 3 and 11 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 3 and 11 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,987,105 to Jenkins et al. (hereinafter, “Jenkins”) in view of U.S. Patent No. 5,311,581 to Merriam et al. (hereinafter, “Merriam”). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claim 3 depends either directly or indirectly from claim 1. Claim 11 depends either directly or indirectly from claim 9. Accordingly, Applicants respectfully request that the rejection of claims 3 and 11 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 9.

E. Rejection of Claims 7 and 16 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 7 and 16 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,987,105 to Jenkins et al. (hereinafter, "Jenkins") in view of U.S. Patent No. 5,729,596 to Reeder et al. (hereinafter, "Reeder"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the

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examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

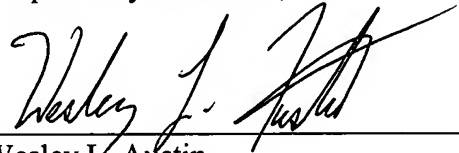
Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claim 7 depends either directly or indirectly from claim 1. Claim 16 depends either directly or indirectly from claim 15. Accordingly, Applicants respectfully request that the rejection of claims 7 and 16 be withdrawn for at least the same reasons as those presented above in connection with claims 1 and 15.

F. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', is written over a horizontal line.

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